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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,968	03/11/2004	Darin L. Moore	IMG.028	4995
26984	7590	09/14/2005		
WILLIAM L. LONDON 3010 LEE AVENUE P.O. BOX 152 SANFORD, NC 27330			EXAMINER FETZNER, TIFFANY A	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/797,968	Applicant(s) MOORE ET AL.	
	Examiner Tiffany A. Fetzner	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

2. The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

3. The disclosure of the prior-filed application, Application No. **10/319,088** fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. (i.e. All of the features of **independent claim 1** are not supported by the prior filed parent application.)

Specifically there is no "drum shutter" feature in the parent application and no teaching in the parent for "a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm". Therefore the limitation of "a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm" from **independent claim 1**, is only an aspect of the applicant's instant **Continuation-In-Part** application, and is therefore only granted a **priority date of March 11<sup>th</sup> 2004**, for this feature / limitation. The **March 11<sup>th</sup> 2004**, date corresponds to the filing date of applicant's instant **Continuation-In-Part** application, and is considered to be the effective priority date for those claims which require the feature of "a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and removing a portion of the first shutter arm" to be present within the claim, since that is the date for which each of the features of applicant's claimed method are disclosed as a combination together. Because this new feature is an aspect of **independent claim 1**,

it is also an aspect of all of applicant's **dependent claims 1-9**. Therefore, for purposes of this examination. **The effective priority date of the instant application is applicant's filing date of March 11<sup>th</sup> 2004.**

#### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

**A)** In **figure 3**, component **102** is shown, however the description of **figure 3**, on page 3 paragraph [0018] through page 4 paragraph [0019], fails to teach component "**102**", in the written description of figure 3.

**B)** In **figure 4**, component **102** is shown, however the description of **figure 4**, on page 3 paragraph [0018] through page 4 paragraph [0019], fails to teach component "**102**", in the written description of figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

5. **Claims 1, 6 and 7** are objected to because of the following informalities:

**A)** With respect to **Claim 6**, this claim is objected to because **claim 6** requires that "**the portions removed from the first shutter arm and waste bin** are selected to allow the toner cartridge to be inserted into the second type of imaging device" However, **claim 1** only provides antecedent basis for "**a portion removed from the first shutter arm**", there is no portion removed from the waste bin" until **claim 2**.

Therefore, **claim 6** lacks proper antecedent basis and/or depends from the wrong claim,

because **claim 6** has the wrong dependency. The examiner suggests that applicant amend **claim 6** to depend from **claim 2**, since it appears that **claim 6** was initially intended to depend from the features disclosed by **dependent claim 2**.

**B)** With respect to **Claim 7**, this claim is objected to because **claim 7** the way this claim is written the connection of **claim 7**, (i.e. the link for the logical chain of dependency) to the steps recited in **claims 1** and **2** is missing. The examiner suggests that applicant **amend claim 7**, to clarify the provided toner cartridge is secured prior to the removal of the shutter arm, and waste bin portions of **claims 1** and **2**. (i.e. a proposed possible correction for **claim 7**, would be to **amend claim 7** as follows:

**Claim 7 (Amended)** "The method of **claim 2** wherein prior to the steps of removing ~~further comprising: securing the drum shutter and the waste bin~~ are secured in a conversion jig comprising a guide path." Appropriate correction is required.

**C)** With respect to **Claim 1**, this claim is objected to because the removing step does not provide a functional modification connection between the first and second type of imaging device. The examiner suggests that applicant consider correcting this problem by using the type of functional linking language of claim 6, such that claim 1 would be amended to recite:

**Claim 1** "A method of modifying a toner cartridge intended for operation in a first type of imaging device to operate in a second type of imaging device, the method comprising:

providing the toner cartridge adapted for operation in the first type of imaging device, said toner cartridge comprising a drum shutter connected to a waste bin, said drum shutter comprising first and second shutter arms; and

removing a portion of the first shutter arm in order to allow the toner cartridge to be inserted into the second type of imaging device".

### ***Claim Rejections - 35 USC § 103***

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claims 1-9** are rejected under **35 U.S.C. 103(a)** as being unpatentable over **Rogers et al.**, US Patent Application Publication **2005/0135836 A1** published June 23<sup>rd</sup> 2005, **filed December 18<sup>th</sup> 2003**. The examiner notes that this reference is applicable as prior art against the claims of the instant application because the instant CIP application has an effective US priority date of **March 11<sup>th</sup> 2004**, for the newly added CIP limitations of the claims. Therefore, the **Rogers et al.**, publication is available as prior art under **35 U.S.C. 103(a)** and **35 U.S.C. 102( e )**.

9. With respect to **Claim 1**, **Rogers et al.**, teaches "A method of modifying a toner cartridge intended for operation in a first type of imaging device to operate in a second type of imaging device" [See abstract, page 1 paragraphs [0006], and [0007]], "the method comprising: providing the toner cartridge adapted for operation in the first type of imaging device, said toner cartridge comprising a drum shutter" (i.e. shutter fin 102 and the shutter main body which encloses and surrounds waste bin 104) "connected to a waste bin" (i.e. waste bin 104) [See page 1 paragraph [0017]], **Rogers et al.**, lacks directly teaching but does suggest from figures 1 and 2 that "said drum shutter" (i.e. the examiner is broadly interpreting the shutter fin component 102, of figure 1; or the modified shutter fin component 202, of figure 2; in combination with the unlabeled shutter main body which encloses waste in 104 as the "drum shutter" of the **Rogers et**

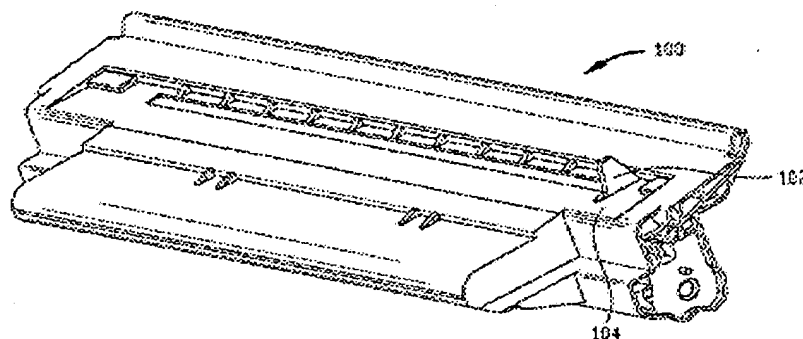
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al., toner cartridge 100,200 in figures 1 and 2.) "comprising first and second shutter

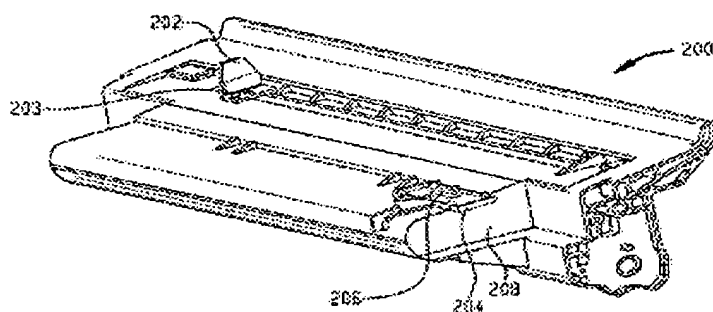
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**FIG. 1**  
(PRIOR ART)



**FIG. 2**

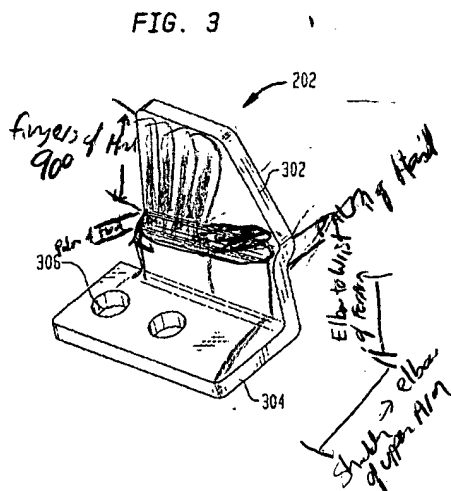


arms" (i.e. See the unlabeled right and left enclosing arm-like structures of the unlabeled shutter main body from prior art figure 1 of **Rogers et al.**, which are located to the right and left of waste bin 104). The examiner notes that shutter fin 102, and/or the modified shutter fin 202 is / are interpreted as an aspect of the shutter main body of figures 1 and 2. The examiner notes that components 102, or 202 are located adjacent to the unlabeled, but illustrated, right / left shutter arm; which is also adjacent to waste bin 104. [See **Rogers et al.**, figure 1 and figure 2]. The examiner also notes that in figure 1 shutter fin 102 is a type of vertical shutter arm located on the right side of the shuttle main body, and that **Rogers et al.**, specifically teaches removing the fin like

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shutter arm portion shown in figure 1, 'with a side cutter or the like' so that the toner cartridge can be installed in a different HP model printer. [See **Rogers et al.**, paragraph [0019]. Therefore It would have been obvious to one of ordinary skill in the art at the time that the invention was made that the **Rogers et al.**, reference, which teaches the limitation of 'removing the shuttle fin also intrinsically removes at least "a portion of a first shutter arm"', by this step (i.e. when prior art figure 1 is considered), even though the **Rogers et al.**, reference lacks identifying the illustrated shuttle arms on the right and left sides, of the prior art and modified shuttle fins of figures 1 and 2 with component numbers. [See **Rogers et al.**, pages 1-2 paragraph [0019], Figures 1 and 2; and the differences between **Rogers et al.**, figures 1 and 2.]

10. Additionally, **Rogers et al.**, teaches replacing the shuttle fin arm-like structure of figure 1 with a new modified shutter fin structure located in a new location on the shuttle main body of the toner cartridge of **Rogers et al.**, [See figures 2 and 3; pages 1-2 paragraphs [0019] and [0020]]. Because the replacement shuttle fin component 202 (i.e. shown clearly in figure 3) is not planar, and the vertical portion zigzags from an initial position to another position, depending on the reference point of one of ordinary skill in the art, there is intrinsically either a removed "upper portion" or a removed "lower portion" with respect to this component. Therefore it also would have been obvious to one of ordinary skill in the art at the time that the invention was made that figure 2, which shows unlabeled shuttle arms on the right and left sides of figure 2 as well as a replacement vertical arm-like shuttle (i.e. component 202), is also capable of satisfying applicant's limitation of a "first shutter arm" with a portion of the shutter arm removed.



Shape of figure 3 is Arm-Like because a Human Arm can form this basic shape

Shoulder to elbow = base 304 with Shoulder of upper Arm →  
 Elbow to Wrist of forearm is 90° with respect to upper Arm ↑ Horizontal  
 Palm of hand bent 90° at Wrist so Palm is up is part of the Offset →  
 Bend fingers 90° to the Palm Vertically Upwards = part 302 ↑



11. With respect to **Claim 2, Rogers et al.**, shows and suggests from figure 2, that the use of modified shutter fin 202 which is arm-like as per the illustration on the previous page, also entails "removing a portion of the waste bin adjacent to the first shutter arm" component 202, in order to mount the base 304 of component 202 to the toner cartridge 200 via the one or more holes 306 through which a screw component 203 attaches the modified shutter fin 202 to the toner cartridge 200. [See figures 2 and 3 pages 1-2 paragraphs [0019] through [0021]. The same reasons for rejection, and obviousness, that apply to **claim 1** also apply to **claim 2** and need not be reiterated.

12. With respect to **Claim 3, Rogers et al.**, lacks directly teaching that "the steps of removing are performed substantially simultaneously", however It would have been obvious to one of ordinary skill in the art at the time that the invention was made that performing both removal steps "substantially simultaneously", is an effective, efficient and economic solution, which is the goal of the **Rogers et al.**, reference. [See page 1 paragraph [0005] Since by performing both removal steps "substantially simultaneously", the removal modification is performed in a single step, and maintains the original alignment of the cutting device with respect to both of the portions to be removed. The same reasons for rejection, and obviousness, that apply to **claims 1, 2** also apply to **claim 3** and need not be reiterated.

13. With respect to **Claim 4, Rogers et al.**, shows and suggests from figures 2, and 4 "removing a second portion of the waste bin" (i.e. component 104) "to form a hole in the waste bin;" [See figures 2 and 4 in combination, where the insertion of mounting patch 204, which is shown to have an alignment member 402 extending downward into a different portion of the waste bin 104 through a slot shaped hole, is shown. See also the text of page 1 paragraph [0008] and page 2 paragraphs [0020] and [0021]. **Rogers et al.**, also shows and suggests from figures 2, and 4 the steps of "attaching a chip mounting patch" (i.e. component 204 of paragraph [0021] "to the waste bin to fill the hole;" [See figures 2 and 4 in combination]. "and attaching a computer chip to the chip mounting patch". [See page 1 paragraph [0008] and page 2 paragraph [0021]]. The same reasons for rejection, and obviousness, that apply to **claims 1, 2** also apply to **claim 4** and need not be reiterated.

14. With respect to **Claim 5, Rogers et al.**, teaches that "the computer chip is adapted for operation with the second type of imaging device". [See the abstract, page 1 paragraph [0008] and page 2 paragraph [0021]]. The same reasons for rejection, and obviousness, that apply to **claims 1, 2, 4** also apply to **claim 5** and need not be reiterated.

15. With respect to **Claim 6, Rogers et al.**, teaches and suggests from the abstract, page 1 paragraphs [0006] and [0007]; and page 1 paragraph [0016] through page 2 paragraph [0021] that "the portions removed from the first shutter arm and waste bin are selected to allow the toner cartridge to be inserted into the second type of imaging device". The same reasons for rejection, and obviousness, that apply to **claim 1** also apply to **claim 2** and need not be reiterated.

16. With respect to **Claim 7, Rogers et al.**, lacks directly teaching the step of "securing the drum shutter and the waste bin in a conversion jig comprising a guide path". However **Rogers et al.**, teaches that in order to correctly position the shutter fin 202, a template (i.e. interpreted by the examiner as being a broad equivalent way of teaching and suggesting the use of a kind of 'conversion jig comprising a guide path'), in order to guide a drill to bore a screw hole for attaching the shutter fin 202. The ability to secure the arm-like [See figure 3 as noted in this action] shutter fin 202 to the modified toner cartridge 200, is also taught by the **Rogers et al.**, reference. [See also the teachings of pages 1-2 paragraphs [0019] through [0021].

17. It would have been obvious to one of ordinary skill in the art at the time that the invention was made that utilizing a modification template to correctly position and guide a drill or side cutter, as per paragraph [0019] directly suggests that the modification template is equivalent to a conversion jig. The examiner notes that securing the "drum shutter and the waste bin" prior to the modification would also have been readily obvious to one of ordinary skill in the art at the time that the invention was made because the use of a cutting or drilling device, without the component to be cut secured, is potentially hazardous. An unrestrained component may move, become misaligned or become a flying projectile, which is highly undesirable. The same reasons for rejection,

and obviousness, that apply to **claims 1, 2**, also apply to **claim 7** and need not be reiterated.

18. With respect to **Claim 8, Rogers et al.**, lacks directly teaching the step of “cutting the first shutter arm” (i.e. component 202) “and the waste bin” (i.e. component 104) “along a path defined by the guide path of the conversion jig”. However **Rogers et al.**, does teach, “cutting the first shutter arm” (i.e. component 202) “and the waste bin” (i.e. component 104) of toner cartridge 200 “along a path defined by the guide path of the” template, (i.e. the examiner considers the template of **Rogers et al.**, to be equivalent to applicant’s conversion jig, for the reasons stated in the **rejection of claim 7** above. [See pages 1-2 paragraphs [0019] through [0021]]. It would have been obvious to one of ordinary skill in the art at the time that the invention was made that the ability to cut and drill by using a guiding template directly suggests use of a conversion jig because the template is of the modification to be cut. The same reasons for rejection, and obviousness, that apply to **claims 1, 2, 7**, also apply to **claim 8** and need not be reiterated.

19. With respect to **Claim 9, Rogers et al.**, teaches that “after the step of removing” [See paragraph [0019] “operating the toner cartridge in the second type of imaging device”. [See the abstract, page 1 paragraphs [0006], [0007] and [0008]; page 1 paragraph [0019] through page 2 paragraph [0021]]. The same reasons for rejection, and obviousness, that apply to **claim 1** also apply to **claim 2** and need not be reiterated.

### Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tiffany Fetzner whose telephone number is: (571) 272-2241. The examiner can normally be reached on Monday-Thursday from 7:00am to 4:30pm., and on alternate Friday’s from 7:00am to 3:30pm.

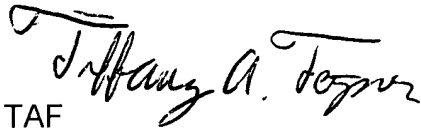
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached at (571) 272-2245. The **only official fax**

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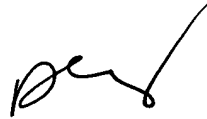
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**phone number** for the organization where this application or proceeding is assigned is  
**(571) 273-8300.**



TAF

September 12, 2005



Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800